

Serial No.: 09/939,938  
Group Art Unit: 2672  
Examiner: F. Fouladi-Semmani  
Atty. Docket No.: 102964-2

### REMARKS

The present Office Action addresses and rejects claims 1-13. Applicant respectfully requests reconsideration of the present application in view of the amendments set forth above and the remarks below.

#### Amendments to the Claims

Applicant amends claims 1, 2, and 4-9 to clarify the claim language. No new matter has been added, and support for the amendments can be found throughout the specification and in the drawings.

#### Rejection Pursuant to 35 U.S.C. §112

On pages 2-4 of the pending Office Action, the Examiner sets forth numerous rejections pursuant to 35 U.S.C. §112, second paragraph. While some of the rejections relate to claim language added by amendment, the majority of the rejections relate to language that was present in the originally filed claims. Since the pending Office Action is a *fourth* Office Action, it is unclear why the Examiner has not yet raised these rejections in the past. Applicant respectfully requests that, in the future, the Examiner avoid any further unnecessary delays in prosecution of the present application and proceed with diligence toward furthering prosecution. To the extent that any additional minor claim amendments may be necessary to place the present application in condition for allowance, Applicant respectfully requests that the Examiner contact Applicant's undersigned representative to resolve these issues.

With regard to the pending rejection, the Examiner rejects claim 1 pursuant to 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In particular, the Examiner argues that the step of "positioning a plurality of templates on the facial image" is not described in the specification. Applicant respectfully disagrees. Page 10, line 16 to page 11, line 26 clearly describes a process for outlining features on a facial image using a plurality of templates. While the specification does not specifically recite "positioning a plurality of templates on the facial image," this step is necessarily disclosed in the application as features on the facial image cannot be outlined using the templates without first positioning the templates on the facial image. Moreover, Figure 4 specifically illustrates a plurality of templates positioned on a facial image, thereby

Serial No.: 09/939,938  
Group Art Unit: 2672  
Examiner: F. Fouladi-Semnani  
Atty. Docket No.: 102964-2

providing clear support for this limitation in claim 1. Applicant further notes that 35 U.S.C. §112, first paragraph states that the specification "shall contain a written description of the invention . . . to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." The specification of the present application clearly and precisely contains a written description of the invention that is more than sufficient to enable a person to perform the recited step of "positioning a plurality of templates on the facial image." Reconsideration and withdrawal of this objection is respectfully requested.

The Examiner further rejects several limitations present in claims 1, 2, and 4-9 pursuant to 35 U.S.C. §112, second paragraph on the basis that there is insufficient antecedent basis for these limitations. While the Applicant disagrees, claims 1, 2, and 4-9 have been amended, and these amendments are believed to obviate the basis for the Examiner's rejections.

The Examiner also rejects claim 10 pursuant to 35 U.S.C. §112, second paragraph, stating that "Claim 10 recites the limitations 'the group' in line 1. There is insufficient antecedent basis for this limitation in the claim." Claim 10 reads "The method of claim 7, wherein the beauty products are selected from *the group* consisting of . . . ." Applicant refers the Examiner to M.P.E.P 2173.05(h), which states that the phrase "selected from the group consisting of . . . ." which is commonly referred to as a Markush group, is acceptable. Accordingly, this rejection is unfounded and reconsideration and withdrawal is therefore respectfully requested.

### Claim Rejections

#### Independent Claim 1

The Examiner rejects claims 1-5 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,293,284 of Rigg in view of JP 02000011144A to Goto. The Examiner argues that Rigg discloses the claimed method, except for the step of "positioning a plurality of templates on the facial image, each template having a shape that substantially corresponds to a feature on the facial image; enabling a user to adjust the shape of each template to outline features on the facial image." Thus, the Examiner relies on Goto, arguing that Goto discloses a system with a plurality of eyebrow templates for deforming and displaying eyebrows in a facial image, and for correcting the eyebrow templates to outline the eyebrow on the facial image. The Examiner argues that it would have been

Serial No.: 09/939,938  
Group Art Unit: 2672  
Examiner: F. Fouladi-Sermani  
Atty. Docket No.: 102964-2

obvious at the time of the invention to one skilled in the art to combine the virtual makeover method of Rigg with the eyebrow deformation system of Goto to "help the user to locate different areas on the facial image and as a result applying the virtual makeover faster and easier." Applicant respectfully disagrees.

As discussed in previous responses submitted by the Applicant, Rigg discloses a virtual makeover that utilizes digital scanning software to *electronically* identify those areas of a facial image upon which color cosmetics can be applied. This is achieved by identifying the natural skin color of the person in the facial image, thereby establishing a "color matching facial foundation for building the first stage of a color makeover." (Col. 2, lines 62-63.) The user can then select from a stored set of colors that match the person's skin type, thereby automatically applying lipstick, eye shadow, etc. to areas *electronically identified* by the software program. The disclosed makeover method does not allow the user to select and outline specific facial features, as taught and claimed by the present invention.

Goto, a translated copy of which is attached hereto, discloses an image processing technique for correcting eyebrows in a facial image. Like Rigg, Goto's technique is performed *electronically*. An image is scanned into the computer, and *the computer processes the image* to determine the location of the eyebrows, using other reference points on the face, and to eliminate and replace the natural eyebrows using an eyebrow template. Goto does not teach or even suggest "enabling a user to adjust the points of the plurality of templates to specify features on the facial image," as required by independent claim 1. Accordingly, neither Goto nor Rigg, taken alone or combined, teach or even suggest the present invention.

Applicant further notes that a person having ordinary skill in the art at the time of the invention would not have modified the virtual makeover of Rigg to include any type of template for highlighting features because Rigg already provides a makeover method that *electronically* identifies areas on the face and applies makeup to those areas. The use of any type of template to outline features on a facial image would actually *diminish* Rigg's current makeover method, as the templates would likely be less accurate and slower than the current electronic identification system disclosed by Rigg.

Serial No.: 09/939,938  
Group Art Unit: 2672  
Examiner: F. Fouladi-Semmani  
Atty. Docket No.: 102964-2

Accordingly, independent claim 1 distinguishes over Rigg and Goto, taken alone or combined, and therefore claim 1 represents allowable subject matter. Claims 2-5 are allowable at least because they depend from an allowable base claim.

Independent Claim 6

The Examiner rejects claims 6 pursuant to 35 U.S.C. §102(b) as being anticipated by Goto. Remaining dependent claims 7-13 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over Goto in view of Rigg.


Independent claim 6 requires the step of "enabling the user to move one or more of the plurality of points selected so as to form a new shape outlining one or more features in the digital photographic image." Accordingly, for the same reasons stated above, independent claim 6 distinguishes over Goto and Rigg, taken alone or combined, and therefore represents allowable subject matter.

Conclusion

In view of the amendments and remarks above, Applicant submits that claims 1-13 are in condition for allowance. Applicant strongly encourages the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

Date: July 18, 2005

  
Lisa J. Michaud, Reg. No. 44,238  
Attorney for Applicant(s)

NUTTER, MCLENNEN & FISH, LLP  
World Trade Center West  
155 Seaport Boulevard  
Boston, MA 02210  
Tel: (617)439-2550  
Fax: (617)310-9550

1447370.1